

rejection is maintained from the previous Office Action. Applicant again respectfully traverses the rejection of these claims.

Prima Facie Obviousness. In the current Office Action, the Examiner asserts that “In response to applicant’s arguments against the references individually, one cannot show nonobviousness by attaching the references individually where the rejections are based on combinations of references.” (Office Action, p. 2). Applicant notes that in the 1.111 Response of August 16, 2005, Applicant clearly argued that none of the references, either alone, or taken together, teaches or suggests the claimed limitation of “enciphering and transmitting use right frequency information for limitation of at least one of a number of times of use, the hour of use and the amount of use of the literary work to one of said customer terminal apparatuses.” (Claim 16). Applicant additionally argued that not only do none of the cited references, either alone, or taken together, teach or suggest this limitation, but that Archibald specifically teaches against the presently claimed invention.

Applicant notes that in order to establish a *prima facie* case of obviousness, three criteria must be met: “First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (MPEP §2143). Thus, in the August 16 Response, as further discussed below, Applicant asserts that the prior art references when combined do not teach or suggest all the claim limitations, because not a single one of the references teaches or suggests the above-

noted limitation (third *prima facie* requirement). Additionally, Applicant asserts that Archibald specifically teaches away from the present invention, and therefore, one of skill in the art would not have been motivated to combine the Archibald reference with other references in order to arrive at the present invention, and there would have been no reasonable expectation of success (first and second *prima facie* requirements).

Prior Art Fails To Teach Or Suggest All Claim Limitations. As previously set forth in the August 16 Response, Applicant submits that the cited combination of references fails to teach or suggest “enciphering and transmitting use right frequency information for limitation of at least one of a number of times of use, the hour of use and the amount of use of the literary work to one of said customer terminal apparatuses.” (Claim 16). Regarding this recitation, Applicant notes that the Examiner must consider each element of this limitation. That is, this limitation requires the enciphering and transmitting of use right frequency information and that the use right frequency information is for limitation of at least one of a number of times of use, the hour of use, and the amount of use of the literary work.

Kazmierczak: In the Office Action, the Examiner asserts that Kazmierczak teaches use right frequency information and transmission to a customer terminal at col. 14, lines 38-67. (Office Action, p. 2-3). Applicants notes that this portion of Kazmierczak describes that a DB info record 222 is transmitted to a user. However, there is no teaching or suggestion that the DB info record 222 includes use right frequency information *for limitation of at least one of a number of times of use, the hour of use, and the amount of use of a literary work.*

With respect to the Examiner's statements that "Kazmierczak discloses the claimed invention except for specifically detailing the use right frequency information for limitation of at least one of the number of times of use, the hour of use and the amount of use of the literary work," (May 16 Office Action, p. 5), the Examiner currently asserts that this "was addressing the specific details of the use right information i.e. number of times of use, the hour of use, and the amount of use of the literary work." (Office Action, p. 2). Regarding these statements, Applicant submits that Claim 16 clearly recites that the use right frequency information is "for limitation of at least one of the number of times of use, the hour of use and the amount of use of the literary work." Thus, because this claim limitation cannot be simply ignored, the Examiner appears to agree that the claimed use right frequency information is not taught or suggested by Kazmierczak.

Archibald: The Examiner asserts that "Archibald is used to show it is well known in the arts that use right information can contain the number of times of use, the hour of use, and the amount of use of the literary work not specifically stated in Kazmierczak." (Office Action, p. 3). The Examiner refers to col. 2, lns. 46-49 of Archibald. This portion of the background of Archibald discusses that piracy prevention systems should not focus on control of distribution and should rather focus on the use of a digital application. First, it is clear from the entirety of the Archibald disclosure that the espoused intent is not to limit the use of an application (as recited in Claim 16: "use right frequency information for limitation of at least one of the number of times of use, the hour of use, and the amount of use"), but rather to charge based on the use of an

application. There is no teaching or suggestion in Archibald of information for limitation of use of an application.

Iwamura: Applicant additionally asserts that Iwamura fails to teach or suggest the above-discussed claim limitation.

No Motivation To Combine And No Reasonable Expectation of Success. As previously discussed, Archibald teaches away from the present invention. The background section of Archibald discusses the drawbacks of a number of piracy reducing techniques that focus on controlling or limiting use of a product, and specifically discloses that the focus of piracy reducing techniques needs to move away from control of distribution. Thus, Archibald teaches away from the presently-claimed invention, reciting use right frequency information for limitation of use of a literary work.

Therefore, in view of the above, Applicant submits that Claim 16 is patentable over the cited combination of references and that Claims 17-20 are patentable at least by virtue of their dependence on Claim 16. Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 16-20.

Conclusion

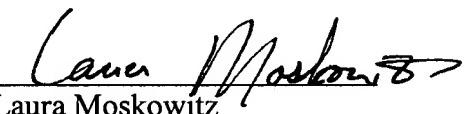
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/834,944

Q64103

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Laura Moskowitz
Laura Moskowitz
Registration No. 55,470

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: January 25, 2006